REMARKS

Claims 1 through 20 are pending in the application.

Claim 1 has been amended to reflect advantageous embodiments of the invention in which the overlayer (A) is formed from polyester consisting essentially of (i) at least one dicarboxylic acid; (ii) at least one aliphatic, cycloaliphatic or aromatic diol and (iii) from 4 to 30 mol % of isophthalic acid units. Support for Claim 1 can be found in the Application-as-filed, for example on Page 6, lines 4 through 12 and Page 4, line 20 through Page 5, line 23.

Claim 1 has been further amended to reflect that the inventive films beneficially exhibit a transparency of greater than 80 %.

Claims 9 and 16 have been canceled, as their subject matter has been incorporated into Claim 1.

Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

Submission of Terminal Disclaimer

Claims 1 through 20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting in light of co-pending Application No. 10/765,242. Solely to advance prosecution of the case and without addressing the merits of the rejection, Applicants respectfully submit herewith a terminal disclaimer, as suggested by the Examiner. More particularly, Applicants submit herewith a terminal disclaimer that disclaims the terminal part of any patent granted on the above-identified application extending beyond the expiration date of the full statutory term which may ultimately result from the cited co-pending application, i.e. Application No. 10/765,242.

Accordingly, Applicants respectfully request withdrawal of this rejection upon entry of the enclosed terminal disclaimer.

The Claimed Invention is Patentable in Light of the Art of Record

Claims 1 through 20 stand rejected over United States Published Application No. 2002/0071945 (US 945) to Peiffer et al. in view of United States Patent No. 4,818,581 (US 581) to Katoh et al.

It may be useful to briefly consider the invention before addressing the merits of the rejection.

The packaging industry has a need for films providing a number of challenging properties, including having a high degree of mattness, good transparency and low opacity. Applicants have determined a particular particle system, a multi-layered film configuration and polymer constitution that imparts a highly advantageous and heretofore unknown balance of mattness, good transparency, low opacity and low volume opacity to the resulting film. In particular, Applicants have determined that the inclusion of isophthalic acid within polyester matt outer layers incorporating a particular pigment system imparts a highly beneficial balance of properties, including improved transparency. (The Examiner's attention is kindly directed to the Application-as-filed on Page 22, line 11 through Page 23, line 7, Example 2 in comparison to Example 3).

Consequently, the claims are directed to polyester films having at least one base layer (B) and at least one matt overlayer (A). The overlayer (A) includes particles that have a median particle diameter d_{50} of from 2 to 10 μm and a SPAN98 smaller than or equal to 2. The overlayer (A) is formed from polyester that consists essentially of (i) at least one dicarboxylic acid; (ii) at least one aliphatic, cycloaliphatic or aromatic diol and (ii) from 4 to 30 mol % of isophthalic acid

units. The inventive films exhibit a transparency of greater than 80 %.

In particularly advantageous embodiments, the inventive polyester films further exhibit an opacity smaller than 45%, as recited in Claim 14, and/or a volume opacity smaller than 15 %, as recited in Claim 15

The matt overlayer (A) beneficially exhibits a gloss smaller than 70, as recited in Claim 17.

The cited references do not teach or suggest the claimed invention.

US 945 is directed to polyester packaging films having a matt outer layer. The matt outer layer includes a pigment system having a maximum diameter of 8 μm and a maximum SPAN98 of 1.9. (Paragraph 0030). The films of US 945 further have a maximum planar orientation of 0.164. (Paragraph 0057).

US 945 notes that its matt films may have a gloss as high as 80. (Table 1 following Paragraph 0078). US 945 remarks repeatedly that its films provide either "good" or "high" transparency (Paragraph 0012; Paragraph 0018; Paragraph 0075). US 945 is altogether silent, however, as to any quantitative transparency values associated with its films.

US 945 initially generically discloses that its polymer may include ethylene isophthalate, in unspecified amounts. (Paragraph 0024). US 945 then goes on to specifically enumerate the formulation for a "Component I." Component I includes both isophthalic acid and sulfomonomer. (Paragraphs 0032 – 0036). The sulfomonomer may be present in amounts of up to 15 mol %. (Paragraph 0035). US 945 incorporates Component I into one of its working examples. (Paragraphs 0115 – 0118).

Applicants respectfully submit that US 945, having a maximum particle diameter of 8 μm and SPAN98 of 1.9, does not teach or suggest the recited particle diameter of up to 10 μm

and SPAN98 of up to 2.

Applicants further respectfully submit that US 945 does not teach or suggest the recited films advantageously including an overlayer (A) formed from polyester that consists essentially of isophthalic acid, dicarboxylic acid and diol. US 945 instead teaches away from such embodiments by recommending sulfomonomer in conjunction with isophthalic acid.

And US 945, altogether silent as to the quantitative transparency of its films, most certainly does not teach or suggest advantageous films incorporating polyester consisting essentially of isophthalic acid, dicarboxylic acid and diol within their matt layer that further exhibit a transparency of greater than 80 %.

US 945 similarly does not teach or suggest films exhibiting an opacity smaller than 45%, as recited in Claim 14, or films having a volume opacity smaller than 15 %, as recited in Claim 15.

And US 945, having a maximum planar orientation of 0.164, most certainly does not teach or suggest advantageous films having a planar orientation of up to 0.170, as recited in Claim 13.

Accordingly, Applicants respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of US 945.

US 581 does not cure the deficiencies in US 945.

US 581 is directed to mono-layered magnetic tapes incorporating spherical silica to improve drop out properties. The magnetic tapes are formed from polyester derived from any of a laundry list of di-carboxylic acids. (Col. 3, lines 49 – 55). In addition to the main acid component, the polyester may further include a maximum of 20 mole % of additional acid. (Col. 4, lines 2 – 6).

US 581 teaches the use of fine spherical silica particles, such as particles as fine as 0.05

micron in diameter. (Col. 4, lines 47 - 49). Typical diameters of spherical silicas within US 581's working examples range from 0.36 to 1.07 microns. (Table 1, Ex 1 and Ex 4). The spherical silica has a standard deviation of 0.5. (Col. 3, lines 21 – 45). US 581 notes that its films may exhibit "high transparency." (Col. 10, lines 32 – 34). US 581 is silent as to any quantitative value for such transparency; however. In addition, US 581 is silent as to the opacity and gloss of its films.

Accordingly, Applicants respectfully submit that US 581, teaching particles as fine as 0.05 microns with a standard deviation of 0.5, does not teach or suggest the recited minimum particle diameter of 2 μm and SPAN98 of less than 2.

Applicants further respectfully submit that US 581, directed to mono-layered films, does not teach or suggest the recited multi-layered films, much less such films advantageously including an overlayer (A) formed from polyester that consists essentially of isophthalic acid, dicarboxylic acid and diol.

And US 581, altogether silent as to the quantitative transparency of its films, most certainly does not teach or suggest such advantageous films further exhibiting a transparency of greater than 80 %.

US 581 similarly does not teach or suggest films exhibiting an opacity smaller than 45%, as recited in Claim 14, or films having a volume opacity smaller than 15 %, as recited in Claim 15.

Nor does US 581 teach or suggest advantageous films having a planar orientation of up to 0.170, as recited in Claim 13.

Accordingly, Applicants respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of US 581.

There would have been no motivation to have combined US 945 and US 581. Applicants respectfully submit that merely because the references can be combined is not enough, there must still be a suggestion. MPEP 2143.01 (section citing *Mills*). US 945 is directed to packaging films having a matt appearance. US 581 is directed to magnetic tapes having improved drop-out properties. These are altogether different fields of endeavor and problems solved, to say the least.

Applicants respectfully submit that polyester films suitable for one application will not automatically work in another application, as each application has its own unique requirements. Therefore, a film for one application may not suggest a solution for another application.

Applicants respectfully submit that the Office Action is instead indulging in impermissible hindsight by merely picking and choosing elements from the prior art while using the instant specification as the guide for that selection process.

However, even if combined (which Applicants submit should not be done), the claimed invention would not result. US 945 teaches a mixture of sulfomonomer and isophthalic acid within a matt layer having a particle system with a maximum diameter of 8 μm and maximum SPAN 98 of 1.9. US 581 teaches mono-layered films including spherical silica particles as fine as 0.05 μm with a standard deviation of 0.5.

Consequently, the combination of US 945 and US 581 would not result in the recited films incorporating a particle system having a diameter of from 2 to 10 μm and a maximum SPAN98 of 2, much less such films advantageously including an overlayer (A) formed from polyester that consists essentially of isophthalic acid, dicarboxylic acid and diol.

And the combination, altogether silent as to the quantitative transparency of its films, most certainly does not teach or suggest such advantageous films further exhibiting a transparency of greater than 80 %.

The combination similarly does not teach or suggest films exhibiting an opacity smaller than 45%, as recited in Claim 14, or films having a volume opacity smaller than 15 %, as recited in Claim 15.

And the combination most certainly does not teach or suggest advantageous films having a planar orientation of up to 0.170, as recited in Claim 13.

Accordingly, Applicants respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of US 945 and US 581, considered either alone or in combination.

CONCLUSION

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1 through 8, 10 through 15 and 17 through 20 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time and/or fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,

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Filing Date: January 20, 2004
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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at facsimile number (571) 273-8300 on August 11, 2005.

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